



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,946	06/22/2001	Mark P. Ashby	018413-331	9583

21839 7590 11/19/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
----------	--------------

3726

DATE MAILED: 11/19/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,946

Applicant(s)

ASHBY ET AL.

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/03 has been entered.

Specification

2. The disclosure is objected to because of the following informalities: On page 1, line 8, it is suggested to delete "the" in its second occurrence. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3726

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Muni et al. (6,190,332).

Muni`332 discloses a guide wire (10) having a substantially cylindrical mandrel (26), wherein the mandrel has one or more segments (28, 46) each having a diameter not exceeding a maximal diameter. Muni`332 discloses providing a wire (26) of a diameter greater than the maximal diameter as shown in Figure 3A, and reducing the diameter of the wire to less than maximal diameter such that a mandrel (26) is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel (26) as shown in Figures 3A-3C and disclosed in column 5, line 47 – column 6, line 13. Muni`332 discloses the step of reducing comprising center-less grinding, and a coil (32) being affixed to the mandrel, wherein the coil is radiopaque. See column 5, lines 14 – 27; column 6, lines 7-13; and Figures 2 – 3C for further clarification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (6,190,332) in view of Cornish et al. (6,132,389).

Muni`332 discloses all of the claimed subject matter except for the step of coating at least a portion of the mandrel with a hydrophilic coating, or coating the mandrel with a lubricious coating, wherein the lubricious coating is applied to all but a proximal portion of the mandrel.

Cornish`389 discloses coating at least a portion of mandrel (12) with a hydrophilic coating, and coating the mandrel with a lubricious coating (26), wherein the lubricious coating may optionally be applied is applied to any additional portion. See *column 3, lines 34 – 60, and Figures 1 and 4 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to coat at least a portion of the mandrel of Muni`332 with a hydrophilic coating, and to coat the mandrel of Muni`332 with a lubricious coating, wherein the lubricious coating is optionally applied to selective portions, in light of the teachings of Cornish`389, in order to effectively reduce the surface friction of the mandrel.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (6,190,332) in view of Applicant's Admitted Prior Art (AAPA).

Muni`332 discloses all of the claimed subject matter except for the step of providing a wire comprising unwinding the wire from a spool, or straightening the wire.

AAPA at page 1 of the specification that it is known in the method of manufacturing a guide wire to select a single drawn/spooled wire and then straighten the spooled wire.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to select the wire of Muni`332 from a single drawn/spooled wire and

Art Unit: 3726

then straighten the spooled wire, in light of the teachings of AAPA, in order to effectively deliver and provide a uniform starting material for the core section of the guide wire.

Response to Arguments

8. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited on the attached PTO-892 shows the manufacture of guidewires.

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

11. If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 703-305-

Art Unit: 3726

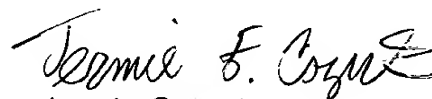
0126. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Listed below are a few helpful numbers and web address for The United States Patent and Trademark Office.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404 or (703) 305-8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257
Information Help Line	(800) 786-9199
Internet PTO-Home Page	http:// www.uspto.gov



Jermie Cozart
Examiner
Art Unit 3726

JC
November 11, 2003